

## REMARKS

Claims 1-11 are pending in the application.

### *Preliminary Matter*

It was confirmed with the Examiner through telephone communications in July 2005 that Claims 8-11 were not addressed in the office action. It is the understanding of the undersigned that the Examiner will consider and treat Claims 8-11 in response to this Response Under 1.116 and that no Advisory Action will be issued yet.

### *Obviousness Rejection*

At page 2 of the office action, claims 1-2, 4-5 and 7 have been rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 6,798,767 to Alexander et al. (newly cited). At page 4 of the office action, claims 3 and 6 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Alexander in view of U.S. Patent 6,731,625 to Eastep et al.

Concerning the independent claims, the examiner's position is as follows.

The examiner cites column 9, lines 20-23 and takes the position that the receiver is inherently contained in the DHCP server and that the server is implicit in the discussion of the use of DHCP. The examiner's further position is that Alexander implicitly discloses the IP address allocation circuit that allocates the IP address of the requesting telephone set in lines 20-23 of column 9. The examiner's position is that in order for the telephony device to get an IP address, one must be allocated. The examiner also cites other parts of column 9 with regard to other claim recitations. It is the examiner's position that the transmitter is implicit in that it is required to request the IP address using DHCP.

At page 3 of the office action, the examiner admits that Alexander fails to expressly disclose: that the ID, extension and the IP address are all stored in a single table; and that the DHCP server is co-located with the call manager 26. However, it is the examiner's position that it would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Alexander to

locate the DHCP in the call manager 26 and to combine tables 4A and 4B. The examiner cites cost reduction as the alleged motivation. The examiner's theory is that in the case of locating the DHCP server in the call manager, the system would cost less due to the reduction in the number of required network elements. (Office action, page 3.) The Examiner also states that in the case of combining the tables, less memory would be required to store the information contained in the tables, because the device names would not have to be duplicated.<sup>1</sup>

Applicants traverse the obviousness rejections as follows.

First, Alexander is more removed from Applicants' claimed invention than the examiner has recognized. In Applicants' invention, the message that the telephone set sends via LAN is before the requesting telephone set has received its IP address and is sent for the purpose of automatically getting its IP address. With Applicants' present invention, a person without knowledge of LAN and IP just connects the new telephone set to the LAN, and the telephone set automatically calls for an IP address to be allocated to itself. That is not what Alexander is disclosing. Rather, Alexander discloses a system for generating line appearances at one or more alternate telephone devices associated with a target telephone device in response to a call made to the target telephony device. (Col. 1, ~line 37.)

Referring to col. 9, beginning at line 20, the part of Alexander on which the examiner relies, Alexander states: "When an IP telephony device is connected to LAN 20, the telephony device gets an IP address using Dynamic Host Control Protocol (DHCP) or other similar protocol or technique." (Col. 9, lines 20-23.) DHCP was a conventional approach. Applicants' claimed invention is not "DHCP or similar protocol or technique." Rather, Applicants have invented telephone controllers and telephone communications systems in which the telephone set automatically calls for an IP address to be allocated to itself and a person knowledgeable about DHCP or other aspects of LAN is no longer needed.

Thus, Alexander is significantly more removed from Applicants' presently

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<sup>1</sup>With regard to claims 3 and 6, the Examiner additionally admits that Alexander fails to expressly disclose that the ID is composed of the domain name of the telephone controller, the extension and the user name. The examiner then cites Eastep as disclosing a director service for allowing a caller to identify the IP address of a called party using a unique identifier (citing col. 83, lines 34-55).

claimed invention than the examiner admitted in the office action dated May 31, 2005.

Further, it would have been impossible for a person of ordinary skill in Applicants' art at the time of the invention to think in the manner that the examiner has proposed. Namely, at the time of applicant's invention (which occurred before the Japanese application filing date of December 27, 1999), the person of ordinary skill in applicant's art lacked the benefit of Alexander, which was only filed November 16, 1999 and thus had not yet been published at the pertinent time of applicant's invention.

The Cisco inventors on the Alexander patent probably should be considered above the level of a person of ordinary skill in applicants' art at the time of applicants' invention, since they patented their work. Even Alexander et al., a group of workers of apparently above-ordinary skill in applicants' art at the time of applicants' invention cannot be said to have arrived at Applicants' invention or even to have been thinking anywhere close to the direction of applicants' invention. There is no way that a person of ordinary skill in the art at the time of applicants' invention could arrive at applicants' invention, because he would not even yet have had the benefit of the Alexander publication.

For the several reasons mentioned above, the obviousness rejections based on Alexander cannot be maintained. Nor does Eastep supply the deficiencies in Alexander discussed above. For simplicity and brevity, Applicants do not comment on each dependent claim at this time. Reconsideration and withdrawal of the obviousness rejections are respectfully requested.

It is respectfully requested that the application be reconsidered, that claims 1-11 be allowed, and that the application be passed to issue.

Should the Examiner find the application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.

A provisional petition is hereby made for any extension of time necessary for the continued pendency during the life of this application. Please charge any fees for such provisional petition and any deficiencies in fees and credit any overpayment of fees to Attorney's Deposit Account No. 50-2041 (Whitham, Curtis & Christofferson).

Respectfully submitted,



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